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EXAMINER

HUTTON JR, WILLIAM D

ART UNIT

PAPER NUMBER

2178

DATE MAILED: 06/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/488,563

Applicant(s)

CARD ET AL.

Examiner

Doug Hutton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 January 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's Response

In Paper No. 5, Applicant amended the Specification, amended Claims 1, 2, 5, 9-11, 14, 18, 19, 23 and 24, and argued against all objections and rejections previously set forth in Paper No. 4.

The objections to the Specification and the Claims are withdrawn.

Claim Objections

Claims 5, 14 and 24 are objected to because of the following informalities:

- the term "materials" in Claim 5, Line 9 should be amended to — material — because that is how the element is previously identified (see Claim 5, Line 3); Claims 14 and 24 have the same problem.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 10-13 and 18-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Goffman, U.S. Patent No. 5,594,897.

Claim 1:

Goffman discloses a method of producing a storage medium that provides information regarding a source material (see Column 7, Line 3 through Column 8, Line 2), comprising the steps of:

- gathering features of the source material (the "source material" is the "starter" journal, and the "gathered features" are the citations of "other" journals located in the starter journal);
- accessing secondary materials related to the features (the "secondary materials" are the "other" journals, which are "accessed" by the information retrieval system; these "secondary materials" are "related to the features" in that the "features" are citations to these journals);
- gathering features of the secondary materials (the "features" are the citations of additional journals in the "other" journals);
- determining attributes of the gathered materials (the "attribute" of each "gathered material" is its "relevance value," which is determined by the information retrieval system);

- analyzing the attributes based on a predetermined characteristic (the “predetermined characteristic” is the “threshold relevance value;” the information retrieval system “analyzes” the “attributes” by comparing the relevance value of each journal to the “threshold” relevance value); and
- recording information regarding the source material and the secondary materials based on the analysis (see Figures 4 and 5; see Column 7, Line 3 through Column 8, Line 2; see Tables 1-10 in Columns 15-20 – the “information regarding the source material” is recorded in the digraphs, tables and trees, as described in the cited text and figures),

wherein the recorded information includes relational information between the source material or one or more of the secondary materials and at least one of the gathered features, the determined attributes or the predetermined characteristic, and wherein the relational information is used in the provision of the information contained within the storage medium (see Figures 4-12; see Column 4, Line 51 through Column 5, Line 10; see Tables 1-10 in Columns 15-20 – the “recorded information” includes “relational information” between the “source material” and at least one of the “gathered features” in that the information recorded in the tables, digraphs and trees pertain to the relevance between the various journals and a numerical measure of that relevance).

Claim 2:

Goffman discloses the method of Claim 1, wherein the determining step includes statistically analyzing the features of the source material and the features of the

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secondary materials (see Column 7, Line 3 through Column 8, Line 2 – the “features” are “statistically analyzed” in that a relevance value is determined for each “other” journal cited by the “starter” journal and each “additional” journal cited by the “other” journals).

Claim 3:

Goffman discloses the method of Claim 1, wherein the determining step includes incrementing an iteration number (see Figure 1B-1; Column 14, Line 48 through Column 15, Line 8 – an “iteration number” is incremented in that the process is repeated until a certain number of journals are collected).

Claim 4:

Goffman discloses the method of Claim 1, wherein the recording step includes recording the source material, features of the source material, the secondary material, and features of the secondary materials (see Table 2 in Column 16 – all of these specifics are recorded as illustrated in the cited table).

Claims 10-13:

These claims are for a computer system that performs the method specified in Claims 1-4. Thus, Goffman discloses every element of Claims 10-13.

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Claims 18-21 and 23:

These claims are for computer software that performs the method specified in Claims 1-4. Thus, Goffman discloses every element of Claims 18-21 and 23.

Claim 22:

Goffman discloses the medium of Claim 18, wherein the storage medium is the Internet (Column 14, Line 34 through Column 15, Line 8).

Claims 5-9, 14-17 and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Lawrence et al., U.S. Patent No. 6,289,342.

Claim 5:

Lawrence discloses a method of providing an interface for graphically displaying information (see Figures 2-6), comprising the steps of:

- displaying information regarding a source material and a set of secondary materials (see Figure 5 – the “source material” is at the top, and the “secondary materials” are at the bottom);
- determining a selection of information based on a user input (see Column 11, Lines 15-37 – the “selection of information” is “determined” “based on a user input” in that the user clicks on “Details” for one of the citations);
- analyzing the source material, the set of secondary materials, and the selection of information in a manner that yields relational information between the source

material or one or more secondary materials and at least one of the selection of information or the information regarding the source material (see Column 2, Line 45 through Column 3, Line 21; see Column 16, Line 5 through Column 18, Line 53 – the citation indexing system “analyzes the source material, the set of secondary materials, and the selection of information” in a manner that yields “relational information” between the “source material” and the “information regarding the source materials” in that it creates a citation index that indicates how often a particular article is cited in a source article; additionally, the citation indexing system discloses the above limitation in that it measures the similarity of collected documents; moreover, the source material, the secondary materials and the selection of information are all “analyzed” during the querying and displaying processes, and these processes yield “relational information” in that they indicate which documents cite other documents); and

- updating the display of information regarding the source material and the set of secondary materials based on the relational information (see Column 11, Lines 24-37; see Figures 5-7 – the citation indexing system “updates the display of information regarding the source material and the set of secondary materials based on the relational information” in that it allows the user to browse the collected documents, as indicated in the cited text and figures).

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Claim 6:

Lawrence discloses the method according to Claim 5, wherein the updating step highlights a particular set of the secondary materials, so as to bring the particular set of the secondary materials to the attention of the user (the citation chosen by the user is a “particular set of the secondary materials,” and it is “highlighted” and brought “to the attention of the user” in that the citation is displayed with the cited document in the context of the citation).

Claim 7:

Lawrence discloses the method according to Claim 5, wherein the displaying step includes displaying a representation of objects of the source material in a first area and displaying a representation of objects of the secondary materials in a second area (see Figure 5 – the “representation of objects” of the source material is at the top, and the “representation of objects” of the secondary materials is at the bottom).

Claim 8:

Lawrence discloses the method according to Claim 7, wherein the updating step rearranges the locations of the representations of the objects of the secondary materials (the locations of the “representation of objects” of the secondary materials are “rearranged” in that, when the user clicks on “Details” for one of the citations, the citation indexing system “updates the display” by presenting the cited document in the context of the citation).

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Claim 9:

Lawrence discloses the method according to Claim 7, further comprising the step of:

- linking the first area and the second area so that a user input to either area will effect the display in the other area (the first area and the second area are both “linked” in that the user can click on hypertext in either area; once the user clicks on the hypertext in either area, the display in the other area is “effected” in that a new display screen is presented to the user).

Claims 14-17:

These claims are for a graphical user interface that performs the method specified in Claims 5-9. Thus, Lawrence discloses every element of Claims 14-17.

Claim 24:

This claim is for computer software that performs the method specified in Claims 5-9. Thus, Lawrence discloses every element of Claim 24.

Response to Arguments

Applicant's arguments filed 27 February 2004 have been fully considered but they are not persuasive.

Arguments for Claims 1-4, 10-13 and 18-23 in regard to Goffman:

Applicant appears to argue that Goffman fails to disclose analyzing the attributes of the gathered materials based on a predetermined characteristic. See *Paper No. 5* – Page 18, first full paragraph.

The examiner disagrees.

The relevant claim language reads: “determining attributes of the gathered materials” (Claim 1, Line 6) and “analyzing the attributes based on a predetermined characteristic” (Claim 1, Line 7). This language is very broad and the “attributes” could include the amount of information gathered, the publication dates of the information gathered or a “statistical” attribute (see Specification, Page 14, Lines 5-12). The “relevance value” for each journal in Goffman could be considered a “statistical attribute.”

As explained in the above rejection for Claim 1, the “relevance value” of each journal that is determined by the information retrieval system in Goffman is an “attribute” of each “gathered material,” and the “threshold relevance value” in Goffman is the “predetermined characteristic.” Finally, the information retrieval system in Goffman “analyzes” the “attributes” based on a “predetermined characteristic” by comparing the “relevance value” of each journal to the “threshold” relevance value.

Moreover, Applicant argues that the only analysis performed in Goffman is a “perusal of the data tree structure between items in the source collection to determine one’s dominance over another.” See *Paper No. 5* – Page 18, first full paragraph. In this context, the data in the “data tree structure” in Goffman are the “attributes” of the

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“gathered materials” and “determining one's dominance over another” is the analysis.

Thus, the relevant claim language also reads on Applicant's interpretation of Goffman.

Applicant argues that Goffman fails to disclose the use of relational data. See *Paper No. 5* – Page 18, first full paragraph.

The examiner disagrees.

The relevant claim language reads: “wherein the recorded information includes relational information between the source material or one or more of the secondary materials and at least one of the gathered features, the determined attributes or the predetermined characteristic, and wherein the relational information is used in the provision of the information contained within the storage medium” (Claim 1, Lines 9-13). The phrase “relational information” is very broad and reads on the “relevance value” disclosed in Goffman, as explained in the above rejection for Claim 1.

Arguments for Claims 5-9, 14-17 and 24 in regard to Lawrence:

Applicant appears to argue that Lawrence fails to disclose the use of relational information and the subsequent update of the display of information based on such relational information. See *Paper No. 5* – Page 18, third paragraph through Page 19, first partial paragraph.

The examiner disagrees.

The relevant claim language reads: "analyzing the source material, the set of secondary materials, and the selection of information in a manner that yields relational information between the source material or one or more secondary materials and at least one of the selection of information or the information regarding the source material" (Claim 5, Lines 6-9) and "updating the display of information regarding the source material and the set of secondary materials based on the relational information" (Claim 5, Lines 10-11). The phrase "relational information" is very broad and reads on the disclosure in Lawrence in several different ways, as explained in the above rejection for Claim 5.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Doug Hutton whose telephone number is (703) 305-1701. The examiner can normally be reached on Monday-Friday from 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached at (703) 308-5186. The fax phone number for the organization where this application or proceeding is assigned is (703) 746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

WDH
May 25, 2004


HEATHER HERNDON
SUPERVISORY PATENT EXAMINER
TECH CENTER 2100